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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,137	06/26/2001	Paul R. Stonikas	BLP 128.1	4376

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EXAMINER

NI, SUHAN

ART UNIT	PAPER NUMBER
2643	13

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,137

Applicant(s)

STONIKAS ET AL.

Examiner

Suhan Ni

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 and 104-126 is/are pending in the application.
- 4a) Of the above claim(s) 118-126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-34 and 104-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the election filed 12/29/2003.
2. A provisional election was made without traverse to prosecute the invention of Group II, claims 21-34. Other Groups, claims 1-20 and 35-103 are withdrawn from further consideration and cancelled by the applicant, 37 CFR 1.142(b), as being drawn to a non-elected invention.
3. Newly submitted claims 118-126 directed to an invention that is independent or distinct from the invention originally claimed, which contains newly introduced limitations, such as "at least one electrical component ...".
4. Since applicants will have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 118-126 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.
5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "a plurality of ribs formed on an exterior periphery of the skin" in claim 28 and others must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R.1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 21-34 and 104-117 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,393,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-44 of U.S. Patent No. 6,393,130 are similar in scope to claims 21-34 and 104-117 of this application with obvious wording variations.

9. Claims 21-34 and 104-117 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,584,207. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-28 of U.S. Patent No. 6,584,207 are similar in scope to claims 21-34 and 104-117 of this application with obvious wording variations.

Claim Rejections - 35 USC § 112, 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 21, the limitation of “the skin does not exhibit sufficient rigidity to be insertable into a user's ear canal” in lines 2-3 is vague since it is not clear what the limitation is.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 21-27, 29-30, 32-34, 104-110, 112-113 and 115-117 are rejected under 35 U.S.C. 102(b) as being anticipated by Basel et al. (U. S. Pat. - 4,962,537).

Regarding claims 21-22 and 104-105, Basel et al. disclose a hearing aid, comprising: a deformable skin (22) bounding an internal region (23); and at least one spine (15) extending axially along an interior surface of the skin, which is attached thereto sufficiently so as to provide insertion rigidity when inserted into the user's ear canal (Fig. 2) as claimed.

Regarding claims 23-24 and 106-107, Basel et al. further disclose the hearing aid, wherein the hearing aid further includes a sound conductive tube (Fig. 3) as claimed.

Regarding claims 25-27, 32-33, 108-110 and 115-116, Basel et al. further disclose the hearing aid, wherein a deformable matrix (23) applying expansive forces to the skin.

Regarding claims 29-30 and 112-113, Basel et al. further disclose the hearing aid, wherein an audio output transducer (9) surrounded, at least in part, by a compressible matrix (Figs. 2-3) as claimed.

Regarding claims 34 and 117, Basel et al. further disclose the hearing aid, wherein a faceplate (6.1) attached to the skin.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 28, 31, 111 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basel et al. (U. S. Pat. - 4,962,537).

Regarding claims 28 and 111, Basel et al. do not clearly teach a plurality of ribs formed on an exterior periphery of the skin as claimed. Since providing cerumen protection or venting elements for the hearing aid is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide a suitable element, such as ribs on an exterior periphery of the skin of the hearing aid, in order to provide protection against cerumen or a hearing aid vent.

Regarding claims 31 and 114, Basel et al. do not clearly teach the matrix comprises at least one of an open cell foam, a closed cell foam, and a fabric as claimed. Since providing a desirable otoplastics material for the hearing aid housing is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide a suitable otoplastics material, such as at least one of an open cell foam, a closed cell foam, and a fabric for the hearing aid, in order to provide more comfort to users.


Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Suhan Ni** whose telephone number is (703)-308-9322, and the number for fax machine is (703)-305-9508. The examiner can normally be reached on Monday through Thursday from 9:00 am to 7:30 pm. If it is necessary, the examiner's supervisor, **Curtis Kuntz**, can be reached at (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900.

Suhan Ni
Patent Examiner
Art Unit 2643
USPTO


SUHAN NI
PATENT EXAMINER

03/13/2004